## REMARKS/ARGUMENTS

The Office Action mailed September 7, 2006 and the Notice of not fully responsive amendment mailed February 27, 2007 has been reviewed and carefully considered. Claims 62-64 are pending in this application. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 62 and 63 are amended to recite the originally claimed subject matter as a process step. Claim 64 is amended to be consistent with claims 62 and 63.

### Traverse of Restriction Requirement

Claims 62-64 were added in the amendment filed by Michael Stuart and dated July 11, 2006, to overcome the restriction requirement in response to suggestions provided by the Examiner's supervisor, Steven Griffen, during a telephone conversation between Michael Stuart and Steven Griffen on July 7, 2006.

The Examiner has now indicated that a constructive election of the original invention is made and that claims 63 and 64 are withdrawn as being directed to a non-elected invention. This restriction requirement is improper and is traversed for the reasons described below.

The original claim 59 was directed to a "Use of recycled calcium carbonate in the treatment of a paper, board, or nonwoven product". The Examiner has acknowledged that new claim 62 is directed to the same invention as original independent claim 59.

MPEP §803 states that there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent or distinct as claimed; and

(B) There would be a serious burden on the examiner if restriction is not required.

As stated in MPEP §803, the term "independent" means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. Furthermore, related inventions are "distinct" if the inventions *as claimed* are not connected in at least one of design, operation, or effect and wherein one invention is patentable over the other.

In the present case, the method recited in claim 63 is related in operation to the use recited in claim 62 because the claim 63 method of treating a paper, board or non-woven product using recycled calcium carbonate is a claim 62 use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product. That is, the recitations of claim 63 are a subcombination of the recitations of claim 62. Accordingly, claims 62 and 63 are related and are not independent. Claims 62 and 63 are also not distinct because the recited inventions of claims 62 and 63 *as claimed* are connected in operation. More specifically, claim 63 includes the same limitations as independent claim 62. Thus, claims 62 and 63 are also not distinct.

Accordingly, the restriction of claim 63 is improper.

Regarding claim 64, this claim is related to, and thus not independent from, claim 62 because claim 64 recites a method of preparing or making recycled calcium carbonate and claim 62 recites a use of recycled calcium carbonate. That is, the recitations of claim 64 are a subcombination of the recitations of claim 62. Accordingly, claim 64 is not independent of claim 62. Furthermore, the steps of preparing recycled calcium carbonate recited in claim 64 are included in the limitations recited in claim 62. Thus, claims 62 and 64 are connected in operation and are also not distinct.

Lastly, since the limitations in both claims 63 and 64 are similar to the limitations of claim 62, there is also no serious burden on the examiner if restriction is not required.

In view of the above remarks, the restriction requirement imposed in the Office Action of September 7, 2006 is deemed improper and consideration of claims 63 and 64 is requested.

**Rejections of Claim 62 under 35 U.S.C. §101, 102, and 112**

The Examiner rejected independent claim 62 under 35 U.S.C. §101 because a use, without setting forth any steps involved in the process, results in an improper definition of a process. Independent claim 62 has been amended to recite a step of "treating the paper, board, or nonwoven product with the recycled calcium carbonate". Accordingly, claim 62 now sets forth a step involved in the use of the recycled calcium carbonate in the treatment of a paper, board, or nonwoven product. Since claim now recites a step involved in the use of the recycled calcium carbonate, claim 62 now qualifies as a process under 35 U.S.C. §101. Furthermore, since the claim now recites a definite process step, the rejection of claim 62 as indefinite under 35 U.S.C. §112, second paragraph, must now also be withdrawn.

Claim 62 stands rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 5,759,258 (Sohara). However, Sohara fails to disclose, teach or suggest "calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product". In contrast, Sohara discloses that a deink residue (DIR) is first heated and then turned to mineral ash (see col. 3, lines 35-40). The mineral ash is then used by Sohara to form the precipitated calcium carbonate (PCC) (see col. 3, lines 40-48 and 62-67; and col. 4, lines 1-9). Cols. 6-7 of Sohara, which are referred to by the Examiner in the rejection, also disclose that the DIR is incinerated to produce mineral ash, which is subsequently used for forming PCC (see e.g., col. 6, lines 37-42; and col. 7, lines 58-67).

Since Sohara fails to disclose "calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board, or nonwoven product", independent claim 62 is allowable over Sohara.

In view of the above amendments and remarks, the application is now deemed to be in condition for allowance.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
COHEN PONTANI LIEBERMAN & PAVANE LLP

By /Alfred W. Froebrich/
Alfred W. Froebrich
Reg. No. 38,887
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

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